

core is between 36 to 42 inches long, but that statement cannot be translated into a "lengthapproximately in the range of the length of the shoulder span of the person using it." A 42 inch shoulder span is quite large, and in any event Jackson, Jr. does not connect the length of the apparatus to any body dimension of the user. See, for example, *In re Dance*, 48 USPQ2d 1635 (Fed. Cir. 1998) wherein the Federal Circuit stated on an analogous issue:

The teachings of the references, their relatedness to the field of the applicant's endeavor, and the knowledge of persons of ordinary skill in the field of the invention, are all relevant considerations.... When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.

Assuming that the person skilled in the art were to extract from Jackson, Jr. his teaching relative to the end caps, they still would not be "adapted to the palm of the hand of the training person," because Jackson, Jr. says nothing on this point. Also, the end caps of Jackson, Jr. does not have a "transition region" as does the apparatus of the present invention. The "transition region" must make "a steady transition into said conversely concave region" which neither reference teaches.

See also *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir 1998), wherein the Federal Circuit also instructed:

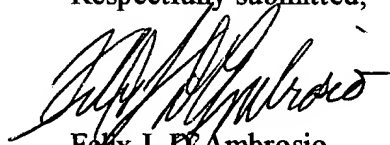
To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to

combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

It is respectfully submitted that here this test has not been met. There is no motivation noted in the references, and if the combination were made the resulting structure would still fall short of the present invention as claimed.

The examiner is urged to reconsider his rejection and find claims 12-23 allowable over the Bosko et al in view of Jackson, Jr.

Respectfully submitted,



Felix J. D' Ambrosio

Reg. No. 25,721

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P.O. Box 2266 Eads Station
Arlington, VA 22202

Tel: (703) 415-1500

Fax: (703) 415-1508